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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,031	01/20/2004	Iris Pecker	27179	7304

7590
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08/02/2007

EXAMINER

DEBERRY, REGINA M

ART UNIT	PAPER NUMBER
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1647

MAIL DATE	DELIVERY MODE
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08/02/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/759,031	PECKER, IRIS	
	Examiner	Art Unit	
	Regina M. DeBerry	1647	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-13 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 5-13 is/are rejected.
- 7) ☒ Claim(s) 22 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Status of Application, Amendments and/or Claims

The amendment filed 04 June 2007 has been entered in full. Claims 3, 4, 14-21 are canceled. New claim 22 was entered. Claims 1, 2, 5-13 and 22 are pending and under examination.

Withdrawn Objections And/Or Rejections

The objection to the disclosure, as set forth at page 2 of the previous Office Action (03 January 2007), is *withdrawn* in view of the amendment (04 June 2007).

The objection to claim 10, as set forth at page 3 of the previous Office Action (03 January 2007), is *withdrawn* in view of the amendment (04 June 2007).

The rejection to claims 1-11 under 35 U.S.C. 112, second paragraph, as set forth at page 3 of the previous Office Action (03 January 2007), is *withdrawn* in view of the amendment (04 June 2007).

The rejection to claims 3, 4, 6, 12 and 13 under 35 U.S.C. 112, first paragraph, enablement, as set forth at pages 3-6 of the previous Office Action (03 January 2007), is *withdrawn* in view of the amendment and Applicant's arguments (04 June 2007).

The rejection to claims 3 and 4 under 35 U.S.C. 112, first paragraph, written description, as set forth at pages 6-8 of the previous Office Action (03 January 2007), is *withdrawn* in view of the amendment (04 June 2007).

Art Unit: 1647

The rejection to claims 12 and 13 under 35 U.S.C. 102(b) as being anticipated by Lin *et al.*, U.S. Patent No. 4,703,008, as set forth at pages 8-9 of the previous Office Action (03 January 2007), is *withdrawn* in view of the amendment (04 June 2007).

Claim Rejections - 35 USC § 112, Second Paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 2, 5-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 (and dependent claims 2, 5-13) is indefinite because it is not clear what the chimeric polynucleotide encompasses. Claim 1 reads on SEQ ID NO:6 or SEQ ID NO:7 including the EPO nucleic acid sequence. Amending the instant claim to recite the claim language recited in new claim 22 would be remedial (i.e. a chimeric polynucleotide comprising a nucleic acid sequence encoding an erythropoietin polypeptide attached to a 5'UTR sequence, *wherein said 5' UTR sequence comprises SEQ ID NO:6 or 7*).

Newly amended claim 12 is indefinite because it is unclear if the eukaryotic cell reads on a cell in tissue culture or a transgenic animal. Amending the instant claim to recite, "An *isolated* eukaryotic cell" would be remedial.

Art Unit: 1647

Claim Objections

Claim 7 is objected to because the instant claim appears to read on the same scope as claim 1. Both claim 1 and 7 read on a nucleic acid construct. Claim 7 does not add any additional structural or functional limitations to claim 1, as the limitations recited in claim 7 do not necessarily define a vector.

Claim 22 is objected to for depending from a rejected claim.

Conclusion

No claims are allowed.

Art Unit: 1647

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Regina M. DeBerry whose telephone number is (571) 272-0882. The examiner can normally be reached on 9:00 a.m.-6:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary B. Nickol can be reached on (571) 272-0835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



RMD
7/30/07

Marianne P. Allen
MARIANNE P. ALLEN
PRIMARY EXAMINER
AU 1647 *8/1/07*